

REMARKS

Claims 1 and 5-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Corey '589 ("Corey") in view of Bollin, Jr. et al. '176 ("Bollin"). This rejection is respectfully traversed for the following reasons.

In order to expedite prosecution, claim 1 has been amended to include the feature of claim 5. Claim 1 as amended recites in pertinent part, "wherein the protein concentration in said solution to be detected is determined based on the intensities of said transmitted light **and** said scattered light" (emphasis added). In imposing a rejection under 35 U.S.C. § 103, the Examiner is required to point to "page and line" wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

In the instant case, the Examiner relies on the combination of Corey in view of Bollin to reject claim 5, but does not identify how the proposed combination discloses the feature recited therein. Indeed, both Corey and Bollin appear silent as to using **both** transmitted light and scattered light in the manner now set forth in amended claim 1. It follows that the Examiner's allegation of obviousness of claim 7 is respectfully traversed. The Examiner admits that Corey does not disclose the correction procedure but asserts that such a procedure "would have been well within the skill in the art." However, as previously mentioned, neither Corey nor Bollin appear to suggest measuring the intensity of **both** transmitted light and scattered light. Moreover, a claimed feature being "well within the skill in the art" is not sufficient to assert obviousness under § 103.

The Examiner is directed to MPEP § 2143.01 under the subsection entitled "Fact that the Claimed Invention is Within the Capabilities of One of Ordinary Skill in the Art is Not Sufficient by Itself to Establish *Prima Facie* Obviousness", which sets forth the applicable standard:

A statement that modifications of the prior art to meet the claimed invention would have been [obvious] because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

In the instant case, the cited prior art does not even "teach that all aspects of the claimed invention [are] individually known in the art", let alone provide the requisite "objective reason to combine the teachings of the" prior art. In contrast, only Applicant's specification discloses and provides the motivation for measuring both transmitted and scattered light intensity. As described on, for example, page 16, lines 4-14 of Applicant's specification, one example of a possible advantage of measuring both types of light intensities is the ability to eliminate conventionally needed steps such as diluting solutions in the high concentration range, thereby increasing accuracy and efficiency, etc..

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 1 because the proposed combination fails the "all the claim limitations" standard required under § 103.

It is noted that the Examiner does not appear to address Applicant's previously filed arguments against the pending rejection of claim 5 (*see, e.g.*, beginning on page 7, fourth line from the bottom of amendment filed October 16, 2003). The Examiner is directed to MPEP § 707.07(f) under the heading "Answer All Material Traversed" sets forth the applicable requirement:

[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

In the instant case, it is respectfully submitted that neither Corey nor Bollin, alone or in combination, disclose or suggest the novel features recited in the combination now set forth in claim 1. The relied on portion of Corey appears to be silent as to the type of light intensity being measured (transmitted or scattered), and the relied on portion of Bollin appears to disclose only measuring and using *one* type of light intensity.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is submitted that claims 1 and 6-7 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103 over Corey in view of Bollin be withdrawn.


CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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